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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER MORGAN ROWDEN

Appeal 2009-011249
Application 09/654,571
Technology Center 2600

Before LANCE LEONARD BARRY, THU A. DANG, and JAMES R.
HUGHES, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals from the Examiner's final rejection of claims 9-16, 18, 19, and 21 under 35 U.S.C. § 134(a) (2007). Claims 1-8 and 20 have been withdrawn and claim 17 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2007).

We affirm.

A. INVENTION

According to Appellant, the invention pertains to landscape planning and, more particularly, to producing a non-specific landscape plan (Spec. 1, ll. 6-8).

B. ILLUSTRATIVE CLAIM

Claim 9 is exemplary and is reproduced below:

9. A process for producing a landscape plan for a property, comprising:

defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen;

assigning a symbol to each generic plant category;

determining locations for plants to be placed on said property with reference to least one image of said property and a survey of said property; and

producing the landscape plan by indicating via said symbols locations for said plants on said property.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Brimberg	US 4,652,239	Mar. 24, 1987
Mykrantz	US 5,246,253	Sep. 21, 1993
Lanckton	US 5,517,419	May 14, 1996

Arthur Cronquist, *An Integrated System of Classification of Flowering Plants*, 800 (Columbia University Press 1981).

Claims 9-16, 18, 19, and 21 stand rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention.

Claims 9-11, 15, 16, and 21 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mykrantz and Lanckton.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mykrantz and Cronquist.

Claims 14, 18, and 19 stand rejected under 35 U.S.C. § 103(a) over the teachings of Mykrantz, Lanckton, and Brimberg.

II. ISSUES

Has the Examiner erred in finding that:

- 1) The claimed method steps do not qualify as a statutory process; and
- 2) The combined teachings of Mykrantz and Lanckton would have taught or suggested “determining locations for plants to be placed on said property with reference to [at] least one of image of said property and a survey of said property” (claim 9)?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Mykrantz

1. Mykrantz discloses a garden planning kit wherein the worksheet 12 may be light brown in color to resemble the color of the soil in the garden, and the location of plants relative each other in the garden to be planted may be represented accurately on the worksheet using the grid 14 and a ruled longitudinal edge 20 of the template (col. 2, ll. 6-11).

Lanckton,

2. Lanckton discloses a terrain mapping system wherein a dataframe is created with stored images and geographic data (Abstract).

IV. ANALYSIS

35 U.S.C. § 101

The Examiner rejects claims 9-16, 18, 19, and 21 as not falling within one of the four statutory categories of invention (Ans. 4-5). Specifically, the Examiner finds that the claimed process “is of sufficient breadth that it would be reasonable interpreted as a series of steps completely performed mentally, verbally or without a machine” (Ans. 5).

Appellant contends that “[t]he [recited] landscape plan is a definite article” and thus “each of the above-recited steps producing it **cannot** be completely performed mentally or verbally without a machine” (Reply Br. 19).

Considering the language of representative claim 9 as a whole, we agree with the Examiner that the process of the claim can be “performed mentally, verbally or without a machine” (Ans. 5). In particular, our reviewing court guides that a claim is drawn to an abstract idea when the method steps can be performed in the human mind, or by using a pen and paper. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372-3 (Fed. Cir. 2011). Here, we conclude that the scope of claim 9’s method steps covers functions that can be performed in the human mind, or by a human using a pen and paper. That is, representative claim 9 simply recites the steps of: (1) “defining a set of generic plant categories” by an undisclosed means; (2) “assigning a symbol to each generic plant category” by an undisclosed means; (3) “determining locations for plants to be placed” by an undisclosed means; and (4) “producing the landscape plan” by an undisclosed means. Such “defining,” “assigning,” “determining,” and “producing” steps may be performed by a human either in the mind or using a pen and paper.

Although Appellant contends that “[t]he [recited] landscape plan is a definite article” and thus “producing it cannot be completely performed mentally or verbally without a machine” (Reply Br. 19), we disagree. That is, the human could “determine” the plan, as recited, in the mind or using a pen and paper without a machine. In fact, even Appellant admits that the plan may be produced using “a sheet of paper, a writing implement, . . .” (Reply Br. 20).

For these reasons, we find that Appellant’s arguments are unpersuasive of error in the Examiner’s rejection of representative claim 9

and claims 10-16, 18, 19, and 21 not separately argued with particularity (Reply Br. 19-20) under 35 U.S.C. § 101.

35 U.S.C. § 103(a)
Claims 9-11, 15, 16, and 21

As for independent claim 9, Appellant merely contends that “Lanckton does not teach determining locations for plants to be placed on a property” (App. Br. 5, emphasis omitted) and that “[p]utting aside for now the prospect of hauling Lanckton’s tractor-trailer through grandma’s backyard garden to help her stick adhesive stickers on Mykrantz’[s] worksheet, ... the Examiner fails to cite anything at all anywhere in the prior art that suggests the reason he offers for the proposed modification of Mykrantz” (App. Br. 6).

However, the Examiner finds that, in Mykrantz’s process for producing a landscape plan, “[t]he location of plants relative each other in the garden to be planted may be represented accurately on the worksheet,” wherein the worksheet “may be light brown in color to resemble the color of the soil in the garden” (Ans. 5-6), and thus “a truly representative appearance of the garden may be achieved” (Ans. 7). The Examiner further finds that, though “Mykrantz fails to explicitly teach that [the] determination of locations for plants to be placed is in reference to a survey of said property,” Lanckton teaches “producing a survey of a property” (Ans. 7-8). The Examiner then concludes that it would have been obvious to incorporate the teachings of Lanckton into those of Mykrantz “because through such incorporation it would allow for a more accurate and realistic looking landscape plan to be generated via the use of accurate data” (Ans. 8-9).

In the Reply Brief, Appellant adds that “no combination of Mykrantz nor Lanckton could ever produce the method of claim 9 that includes

determining locations for plants to be placed on a property with reference to at least one image of the property and a survey of a property” (Reply Br. 8). In particular, Appellant contends that “no one of ordinary skill in the art at the time of the invention would have sought to modify Mykrantz’[s] garden planning kit by first hauling Lanckton’s tractor’s trailer through the garden to help her stick adhesives stickers on Mykrantz worksheet” (Reply Br. 9).

Mykrantz discloses a garden planning kit wherein the worksheet is provided to resemble the garden, and plants to be planted in the garden are represented accurately on the worksheet (FF 1). We find Mykrantz’s positioning of the plants on the worksheet to comprise determining locations for the plants in the garden. Thus, though Appellant argues that Lanckton does not disclose “determining locations for plants to be placed on a property” (App. Br. 5, emphasis omitted), we find Mykrantz to disclose determining locations for plants to be placed on a property.

Further, since the worksheet is provided to resemble the garden and the placement of the plants in the garden is represented accurately, we find such placement of the plants to comprise referencing the survey of the garden. That is, we find that providing a worksheet to resemble the garden, (such as providing the accurate color of the soil) and then accurately placing the plants in the garden at the least comprise examining, ie., surveying, the garden. Thus, we find Mykrantz to, at the least, suggest determining locating the plants with reference to “[*at least one* image of said property and *a survey of said property*” (claim 9, emphasis added).

Furthermore, Lanckton discloses a terrain mapping system wherein images and geographic data are stored for subsequent mapping (FF 2). Thus, we find no error in the Examiner’s finding that the combined

teachings of Mykrantz would at least have suggested “determining locations for plants to be placed on said property with reference to [at] least one of image of said property and a survey of said property,” as recited in claim 9.

Although Appellant argues that the combined teachings would require “hauling Lanckton’s tractor-trailer through grandma’s backyard garden to help her stick adhesive stickers on Mykrantz’s worksheet” (App. Br. 6), and that “no one of ordinary skill in the art at the time of the invention would have sought to modify Mykrantz’s garden planning kit by first hauling Lanckton’s tractor’s trailer through the garden to help her stick adhesives stickers on Mykrantz’s worksheet” (Reply Br. 9), Appellant appears to view the references from the different perspective than that of the Examiner. That is, the question is not whether the ordinarily skilled artisan would have modified Mykrantz “by hauling Lanckton’s tractor-trailer through grandma’s backyard garden” (App. Br. 6), but whether the artisan would have used Lanckton’s survey of the property as the representation of the property for landscape planning as taught by Mykrantz. We see no error in the Examiner’s conclusion that the ordinarily skilled artisan would have found it obvious to use Lanckton’s stored survey data to Mykrantz’s landscape planning.

Appellant has provided no evidence that incorporating the teachings of using stored survey data of a property as representing the property for landscape planning was “uniquely challenging or difficult for one of ordinary skill in the art,” *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), nor have Appellant presented evidence that this incorporation yielded more than expected results. Rather, we find that Appellant’s invention is simply an arrangement of the known

teachings. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraid v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Accordingly, we find no error with the Examiner’s rejection of claim 9 and claims 10, 11, and 15 depending therefrom over Mykrantz and Lanckton.

As to claims 16 and 21, Appellant adds that the prior art references do not teach “providing a list of specific plants belonging to each generic plant category” (claim 16) and “determining the locations for said plants to be placed on said property in accordance with a list of desired landscape characteristics for the property provided by an owner of the property” (claim 21). However, we find such terms “of specific plants belonging to each generic plant category” and “of desired landscape characteristics for the property provided by an owner of the property” do not further limit the claim. That is, the “of specific plants” and “of desired landscape characteristics for the property provided by an owner of the property” terms are merely descriptions of the lists/data provided without providing additional functions; thus, Appellant’s arguments are predicated on nonfunctional descriptive material. In particular, the argued steps of “providing” and “determining the locations” are not altered or performed differently according to the particular type or content of list. The content of such nonfunctional descriptive material is not entitled to weight in the patentability analysis. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-1888 (BPAI 2008) (precedential). Accordingly, we conclude claim 16 and 21

merely require performing the locations of the plants in accordance with a set of data and then providing data output.

We find no error in the Examiner's finding with respect to claim 16 that "the respective claim language fails to disclose what exactly constitutes a 'list' and thus it is noted a sheet containing a plurality of decals [as taught by Mykrantz] ... is considered to read on a list" (Ans. 9-10). Similarly, as to claim 21, we find no error in the Examiner's conclusion that the determination step would at least have been suggested by the combined teachings of Mykrantz and Lanckton (Ans. 10).

Claims 12 and 13

As to claims 12 and 13, Appellant merely argues that "Cronquist merely teaches that plants can be classified as deciduous or evergreen" and that "Mykrantz does not disclose dividing generic plant categories into a first subset of generic plant categories corresponding to deciduous plants and a second subset of generic plant categories corresponding to evergreen plants" (App. Br. 9). However, Appellant is arguing the references individually when the test for obviousness is not what each reference shows but what the combined teachings would have suggested to one of ordinary skill in the art. We see no error in the Examiner's conclusion that the ordinarily skilled artisan would have found it obvious to use Cronquist's known teaching of classifying plants as deciduous or evergreen to Mykrantz's landscape planning using different classifications of plants to accurately represent the garden in different times of the year.

Appellant has provided no evidence that incorporating the teachings of using deciduous or evergreen trees as representing the plants for landscape planning in different times of the year was "uniquely challenging

or difficult for one of ordinary skill in the art,” *Leapfrog*, 485 F.3d at 1162, nor have Appellant presented evidence that this incorporation yielded more than expected results. As discussed above, “‘arrang[ing] old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 550 U.S. at 417. Accordingly, we find no error in the Examiner’s rejection of claims 12 and 13 over Mykrantz in view of Cronquist.

Claims 14, 18, and 19

Appellant does not provide separate arguments for claims 14, 18, and 19 separate from claim 9 from which they depend but merely contends that “Brimberg does not remedy the shortcoming of Mykrantz and Lanckton” (App. Br. 10). However, as discussed above with respect to claim 9, we see no shortcoming with respect to Mykrantz and Lanckton. Accordingly, we see no error in the Examiner’s rejection of claims 14, 18 and 19 over Mykrantz and Lanckton and in further view of Brimberg.

CONCLUSION AND DECISION

The Examiner’s rejection of claims 9-16, 18, 19, and 21 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

peb